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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,857	05/14/2001	Lance E. Brothers	HES 99.0350U1C1	1002
7590 06/09/2004				
EXAMINER				
MARCANTONI, PAUL D				
ART UNIT		PAPER NUMBER		
1755				

DATE MAILED: 06/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,857

Applicant(s)

BROTHERS ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's amendment and response filed 3/29/04 have been fully considered but they are not persuasive.

35 USC 103 Rejection:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-40 remain rejected under 35 U.S.C. 103(a) as obvious over Reddy et al. (US 6,273,191B1) alone or in view of Cowan et al. '991 or Gilbert et al. '866.

Reddy et al. teach cement composition comprising calcium aluminate cement, accelerator, retarder, water, as well as foam forming and foam stabilizing surfactants thus anticipating the instant invention. Even if not anticipated, Reddy would appear to teach the same components in overlapping amounts. Cowan et al. and Gilbert et al. would appear to teach that the use of lithium salts as accelerators for aluminous cements including those used for subterranean formations would have been obvious to one of ordinary skill in the art. Note that in column 7, first paragraph Reddy et al. teach that a variety of cement set accelerators may be used, calcium salt accelerators such as calcium chloride, calcium nitrite, and calcium formate are preferred. A reference, however, is good for all that it realistically teaches and is not limited to the preferred embodiments. Lithium salts were known at the time of applicants' invention for use in subterranean formations and for aluminous cements and the use of other known or

conventional accelerators in the Reddy et al. cement composition would have been obvious to one of ordinary skill in the art because they were known accelerators for subterranean formations at the time of applicants invention.

Cowan et al. also teach that the set retarder for cement can be gluconic acid, tartaric acid, and hydroxycarboxylic acid (e.g. citric acid) which meets the limitations of the claimed invention.

Response:

Note: This is the response to prior to the mailing of the non-final office action of 5/28/03.

The applicants have limited their invention or claimed cement composition to "consisting essentially of" claim language. The applicants argue that because Reddy teaches using low amounts of calcium aluminate cement in the range of 0.5 to 5 wt%

In rebuttal, when applicants contends that the modifying components in the reference are excluded by the recitation of "consisting essentially of", applicants have the burden of showing the basic and novel characteristics of their composition – i.e. a showing that the introduction of these components would materially change the characteristics of the applicants' composition. In re Delajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

It is the examiner's position that while the additional hydraulic cement (ie Portland cement or equivalent cement) is the cement present in the greatest amounts in Reddy '191 B1, the applicants have not shown that the presence of this additional

hydraulic cement would materially change the characteristics of the applicants' composition. Absent this showing, the applicants' arguments are not convincing.

The applicants' 4/1/04 amendment is respectfully acknowledged. It would appear that the examiner sent out a notice of non-compliant amendment on 9/10/03 because applicants did not actually respond to the rejection by pointing out how the prior art does not teach their instant invention. The applicants resubmitted amendment again contains no response to the rejection as far as why it is different than the claimed invention. As a result, the applicants amendment does not overcome the rejection because they did not point out how the prior art rejection teaches away from their instant invention. The finality of this office action is now proper. Applicants may still be able to rebut the rejection in an after final response but as of yet there are no rebuttal arguments to the examiner's rejection. The rejection thus stands.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755